

REMARKS

Claims 1-48 are pending in this application. Claims 1, 15, 24, 26-28, 30-32, 34-36, 38-40, 42-44 and 46-48 have been amended and claims 49-52 are new. Applicants reserve the right to pursue the original claims and other claims in this and in other applications.

The Application has been carefully reviewed in light of the Office Action mailed on November 24, 2005. Reconsideration of all outstanding rejections and objections in view of the foregoing amendments and following remarks is respectfully requested.

Claims 24, 26-28, 30-32, 34-36, 38-40, 42-44, and 46-48 have been amended for clarification but not in response to cited art.

Claims 1-3, 10, 11, 17, 24-26, 32-34, and 48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Cromer et al. (U.S. Pat. No. 6,314,455) ("Cromer"). Applicant respectfully traverses this rejection.

Cromer discloses a data processing system and method for addressing errors in a computer's boot block. ("for permitting a server computer system to remotely initiate a boot block recovery.") (Cromer, Summary, Col. 2, ll. 33-36)

Claim 1 recites, inter alia, a method of recovering from a corrupt computer system BIOS comprising the steps of "upon startup, determining whether a BIOS of a computer system is corrupt; continuing with a normal boot if said BIOS is not corrupt; if said BIOS is corrupt: initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server; locating said recovery server; connecting to said recovery server and sending system information to said recovery server; downloading an uncorrupted version of said BIOS from said recovery server based on said system information; programming said uncorrupted BIOS onto said computer system's BIOS storage area; and rebooting said computer system."

As indicated in Cromer :

A computer system requires a basic input/output system (BIOS) in order to operate. The BIOS is code that controls basic hardware operations, such as interactions with disk drives, hard drives, and the keyboard.

When a computer is reset or initially powered-on, a boot process begins. First, POST begins executing. POST is an initialization code which configures the system utilizing initialization settings stored in storage, such as CMOS storage. Once POST has configured the system, BIOS then controls the basic operation of the hardware utilizing the hardware as it was configured by POST. The boot process is complete once an operating system has been handed control of the system. In order for the boot process to be complete, POST must complete its execution.

POST and BIOS are both typically stored as a single flash image in a storage device such as a flash memory. This image is commonly called the 'boot code'. If the flash image of POST and BIOS is corrupted, the boot of the system will not be able to be completed.

To recover from a defective flash image error, known systems include a boot block. The boot block is storage within the flash memory which includes a small segment of code sufficient to bring the system up, and to read a recovery image from a floppy drive. A diskette must be inserted into the floppy drive which includes a good copy of the flash image. The code stored in the boot block is not typically updated.

(Cromer, Col. 1, l. 56 – Col. 2, l. 17). The computer system of Cromer is different from standard computer systems as the invention of Cromer is described as always starting-up from the boot block and not the boot code. (Cromer, col. 3, ll. 23-25 “The client always initiates the start of POST utilizing the code stored in the boot block.”) Additionally, Cromer’s system is concerned with replacing corrupted POST code. (“The server transmits a recovery POST code....” (Cromer, Col 30, ll. 39-40)

By contrast, the claimed invention “initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server” if it is determined that the “BIOS of a computer system is corrupt” If there is an error in the BIOS, then the computer utilizes the boot block in “locating said recovery server; connecting to said recovery server and sending system information to said recovery server; downloading an uncorrupted version of said BIOS from said recovery server based

on said system information; programming said uncorrupted BIOS onto said computer system's BIOS storage area; and rebooting said computer system.”

Furthermore, the claimed invention concerns corrupted BIOS and “downloading an uncorrupted version of said BIOS from said recovery server based on said system information;” and “programming said uncorrupted BIOS onto said computer system's BIOS storage area” in contrast to Cromer's concern with POST code.

Therefore, the computer system of the claimed invention is different from the computer system of Cromer and the anticipation rejection of claim 1 should be withdrawn for at least that reason.

Claims 2-3 depend from claim 1 and incorporate, directly and indirectly, all the limitations thereof and are allowable for at least the reason noted above. Therefore the rejection of claims 2-3 should be withdrawn.

As claims 17, 24-26, 32-34, and 48 have a similar limitation as claim 1, the rejection of claims 17, 24-26, 32-34, and 48 should be withdrawn for at least the reason noted above.

With respect to claims 10 and 11, as noted above, the server of the claimed invention transmits “an uncorrupted version of said BIOS to said computer system” contrary to the system of Cromer which is concerned with POST code. Therefore the rejection of claims 10 and 11 should be withdrawn.

Claims 15-23 stand rejected under 35 U.S.C. § 103 (a) as being obvious over Cromer in view of Aoki (Japanese Pat. No. JP409258965A) (“Aoki”). Applicant respectfully traverses this rejection.

Applicant respectfully suggests that Office inappropriately relies on the Aoki reference. The Office has provided a copy of the patent in Japanese and only provided a English translation of the abstract. As the Office has not indicated whether it is relying on

the abstract or the full text of the document and has not provided an English translation of the Aoki reference, the reference is inappropriately applied. (MPEP 706.02)

Additionally, it appears that the invention of Aoki is an update server. The use of a server to provide updated software is directed at a different problem than addressed by the claimed invention.

Claim 15 recites, *inter alia*, a method for recovering from a corrupt BIOS comprising the steps of: “upon startup of a computer system, checking whether a BIOS of said computer system is corrupt; continuing with a normal boot if said BIOS is not corrupt; if said BIOS is corrupt: initializing components in a boot block of said computer system sufficient to establish a communications connection with a recovery server; locating a recovery server; connecting to said recovery server and sending system information to said recovery server; transmitting, based on said system information, an uncorrupted version of said BIOS and an utility software from said recovery server to said computer system; receiving said uncorrupted version of said BIOS and said utility software at said computer system; executing said utility software to program said uncorrupted version of said BIOS onto a BIOS storage area of said computer system; and rebooting said computer system.”

The Office Action admits that Cromer does not disclose, *inter alia*, “transmitting ... an uncorrupted version of said BIOS and an utility software from said recovery server to said computer system ... executing said utility software to program said uncorrupted version of said BIOS onto a BIOS storage area of said computer system” as in claim 15. The Office Action then continues by stating that sending a flash update utility along with a flash update is well known in the art (without any cite). Applicant respectfully disagrees.

Applicant notes that the Office Action recognizes a difference between the claimed invention and the sending of system information to an update server. According to the Office Action, the Windows update function connects to “A host station 1 transmits an update program obtained by previously changing the operation and the version of the

program to the base station2.” The recovery server, as defined in claim 15, performs the function of “transmitting...an uncorrupted version of said BIOS and an utility software....” The Aoki update feature downloads an update regardless of whether or not there is any corruption in an existing software program, thus is a very different operation than the method described in claim 15 where a corrupted BIOS is first recognized and then a BIOS recovery using a remote server is initiated.

Moreover, the Aoki update feature relies completely on a computer with a fully operative BIOS system. It could not be implemented on a system with a corrupted BIOS since the computer would not properly boot in the first place.

MPEP § 2143 sets forth the requirements to be shown by the Examiner in order to have successfully established a prima facie case of obviousness. To establish a case of prima facie obviousness: i) there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, ii) there must be a reasonable expectation of success, and iii) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Moreover, MPEP § 2143.01 states that some *additional objective reason* to combine the teachings of references must be shown by the Examiner. That is, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art itself also suggests the desirability of the combination. MPEP § 2143.01 quoting In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990).

No such teaching, suggestion or motivation is present in the cited references or indefinitely described art. Without using the present claims as a roadmap, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from the cited references. The rejections are based on an impermissible hindsight reconstruction of the present invention from the cited references. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. App. 1985) (requiring “convincing line of reasoning” to

support obviousness determination). The fact that the present invention was made by the Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). See e.g. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051 (Fed. Cir. 1988) (It is impermissible to reconstruct the claimed invention from selected prior art absent some suggestion, teaching or motivation in the prior art to do so). Accordingly, the outstanding rejection of claim 15 is not well founded, thus claim 15 is allowable.

Claims 16-23 depend from claim 15, thus are also allowable for at least the reasons noted above.

Claims 4-9, 12-14, 27-31, and 35-39 stand rejected under 35 U.S.C. § 103 (a) as being obvious over Cromer. Applicant respectfully traverses this rejection.

The rejection of claims 4-9, 12-14, 27-31, and 35-39 should be withdrawn for at least the reasons noted above indicating the differences between the claimed invention and the invention of Cromer.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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